

REMARKS

REJECTIONS UNDER 35 U.S.C. § 112

Applicant gratefully acknowledges that the Request for Continued Examination under 37 CFR 1.114 has been granted.

Claims 1-22 are cancelled. Claims 45-54 are withdrawn as being directed to a non-elected invention. Claims 23-44 are rejected.

Claims 23-44 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description. Claims 24-44 are dependent, either directly or indirectly, on claim 23. Applicant respectfully traverses this rejection.

Applicant respectfully directs the Examiner's attention to, *inter alia*, page 9, lines 8-19, page 23, lines 24-30, page 24, lines 1-2 and page 25, lines 7-16. In particular, the Examiner rejected "the encrypted hash value generated by the certifying authority after logging the recipient on to the certifying authority" and "after logging the recipient on to the certifying authority, generating by the certifying authority, generated by the certifying authority an encrypted hash value..thereof". For example, on page 9, lines 8-19 includes, *inter alia*:

the method comprising the steps of: receiving an electronic package that is transmitted from the sender to the certifying authority via the public communications network; generating an encrypted hash value based on particulars surrounding the electronic package, the encrypted hash value uniquely identifying said particulars; storing the electronic package and the encrypted hash value on a server operated by the certifying authority for use in later verifying the particulars surrounding the electronic package; delivering the electronic package from the certifying authority to the recipient via the public communications network; and transmitting an electronic certificate of service from the certifying authority via the public communications network, the electronic certificate of service including the particulars of the electronic package

and the encrypted hash value as verification of the content and delivery of the electronic package from the certifying authority to the recipient. As is clearly disclosed, one of the functions of the certifying authority is “generating an encrypted hash value based on particulars surrounding the electronic package, the encrypted hash value uniquely identifying said particulars.” It is respectfully submitted that this disclosure is enabling for the claim language and that a person skilled in the art is able to practice the invention as claimed based on the disclosure. As such, it is submitted that claim 23, as amended, is proposed to be in a condition for allowance.

Reconsideration of the rejection of claim 23 under 35 U.S.C. § 112 is respectfully requested in light of the amendments and remarks above.

Claims 24-44 are dependent either directly or indirectly on claim 23 and therefore should be allowable for the reason stated above and reconsideration of dependent claims 24-44 is respectfully requested in light of the amendments and remarks above.

Claims 23-44 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description. Claims 24-44 are dependent, either directly or indirectly, on claim 23. Claim 23 is amended to clarify that there is only one certifying authority. Reconsideration of the rejection of claim 23 under 35 U.S.C. § 112 is respectfully requested in light of the amendments and remarks above.

Claims 24-44 are dependent either directly or indirectly on claim 23 and therefore should be allowable for the reason stated above and reconsideration of dependent claims 24-44 is respectfully requested in light of the amendments and remarks above.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 23, 25-31, 36, 38 and 41-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kara (U.S. Patent Number 6,297,891) in view of Smith et al (U.S. Patent Number 6,385,655). Applicant respectfully traverses this rejection.

Applicant's invention, as defined in amended claim 23, includes, *inter alia*, "logging the sender on to the certifying authority using a standard authentication protocol". The Examiner states that Kara discloses "logging the sender on to a certifying authority". The Applicant in the disclosure under the Definitions (page 5) defines Certifying Authority:

is the group of PoS-e personnel who audit a Secure File Storage Server 400 pursuant to a Requisition for the production of a Physical Certificate and a duplicate of a Message and Attachment(s), if any, and preferably consists of the Chief of Information Technology, the Chief Operating Officer and the Custodian of Records.

Kara discloses a "Certification program" which is not equivalent in function nor operation to the present invention's Certifying Authority. The present invention's Certifying Authority is not a program. Applicant respectfully submits that the present invention's Certifying Authority is not disclosed nor suggested by Kara. Likewise, Smith does not disclose, teach nor suggest the use of a Certifying Authority as defined and disclosed by the present invention.

Since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 23 is patentable over the combination of Kara in view of Smith.

Examiner rejects claim 25 based on Kara disclosing "the certifying authority embeds the digital certificate on the face of the electronic certificate of service". Applicant respectfully traverses this rejection. Kara does not disclose a system where the "certifying authority embeds the digital certificate on the face of the electronic certificate of service". For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a

crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 23 is patentable over the combination of Kara in view of Smith. However, even if *arguendo*, the Examiner finds that Kara does disclose a Certifying Authority, Kara does not disclose, teach nor suggest embedding the digital certificate on the face of the electronic certificate of service. As disclosed on page 23, lines 16-23 and figure 12, the present invention's embedding the digital certificate on the face of the electronic certificate of service is a physical embedding as clearly indicated in figure 12. The checksum disclosed in Kara is not printed on any certificate. It remains internal to the system as is known in the art. The present invention prints the digital certificate as part of the proof of service. Likewise, Smith neither discloses, teaches nor suggests printing a digital certificate on the face of the electronic certificate. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that dependent claim 25 is patentable over the combination of Kara in view of Smith. Also, claim 25 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 26 based on Kara disclosing "the certifying authority embeds the digital certificate in the electronic certificate of service". Applicant respectfully traverses this rejection. Kara does not disclose a system where the "certifying authority embeds the digital certificate on the face of the electronic certificate of service". For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the

teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 26 is patentable over the combination of Kara in view of Smith. Also, claim 26 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 27 based on Kara disclosing “wherein a recipient, sender or other person requests the certifying authority to employ the digital certificate embedded within the electronic certificate of service so as to verify that the contents of the electronic package stored on the certifying authority's server are identical to the description thereof found on the face of the electronic certificate of service.” Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant’s Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 27 is patentable over the combination of Kara in view of Smith. Also, claim 27 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 28 based on Kara disclosing “wherein the certifying authority utilizes the embedded digital certificate within the electronic certificate of service to locate and identify the electronic package.” Applicant respectfully traverses this rejection. For the reasons stated above,

Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 28 is patentable over the combination of Kara in view of Smith. Also, claim 28 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 29 based on Kara disclosing "wherein the certifying authority, having located and identified the electronic package, reproduces the electronic package identically to that first assembled by the certifying authority." Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 29 is patentable over the combination of Kara in view of Smith. Also, claim 29 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 30 based on Kara disclosing "wherein the reproduced electronic package is certified to be a true and correct copy of the original electronic package, such certification being made by the certifying authority." Applicant respectfully traverses this rejection. For the reasons

stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 30 is patentable over the combination of Kara in view of Smith. Also, claim 30 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 31 based on Kara disclosing "wherein the certifying authority issues a certification to a requesting party that the reproduced electronic package is a true and correct copy of the original electronic package and said certification and electronic package are delivered to said requesting party." Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 31 is patentable over the combination of Kara in view of Smith. Also, claim 31 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 36 based on Kara over Smith. Applicant respectfully traverses this rejection. Claim 36 is dependent from claim 23.

Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 43, however, the language quoted is from claim 44. Applicant respectfully points out that the Examiner is silent as to the rejection of claim 43. Applicant is responding to the rejection of claim 44 which the Examiner based on Kara disclosing “wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service to a designee of the sender other than the recipient.” Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant’s Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 44 is patentable over the combination of Kara in view of Smith. Also, claim 44 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 41 based on Kara disclosing “wherein particulars of the inputs of the recipient that are converted to an electronic package by the certifying authority are encrypted using an encrypted key maintained solely by the certifying authority for the purpose of embedding the same into the electronic certificate of service” Applicant respectfully traverses this rejection. Kara discloses a public and private key. The present invention, as claimed in claim 41, utilizes an encrypted key maintained solely by the Certifying Authority. Kara does not use this scheme and in fact depends on a key outside the control of the Kara system. For this reason, Applicant

respectfully submits that claim 41 is patentable over Kara either alone or in combination with Smith since both lack the crucial teaching. Additionally, for the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that Smith lacks a crucial teaching, it cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 41 is patentable over the combination of Kara in view of Smith. Also, claim 41 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 42 based on Kara over Smith. Applicant respectfully traverses this rejection. Claim 42 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 38 based on Kara over Smith. Applicant respectfully traverses this rejection. Claim 38 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Claims 24, 32-35, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Smith in further view of Cook.

Examiner rejects claim 24 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 24 is patentable over the combination of Kara in view of Smith in further view of Cook. Also, claim 24 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 35 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 35 is patentable over the combination of Kara in view of Smith in further view of Cook. Also, claim 35 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 32 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 32 is patentable over the combination of Kara in view of Smith in further view of Cook. Additionally, the Examiner asserts that Cook discloses the maximum number of days within which to deliver the electronic package to the recipient by referring to figure 4c in Cook. Applicant respectfully traverses this assertion. Figure 4c is not even referenced in the specification other than in the brief description of the drawings and figure 4c merely shows a "days to hold message", not the required notification after a "predetermined number of days after the certifying authority assembles an electronic package..." Because this function is absolutely required for a Proof of Service, a mere mention of holding a message. Applicant respectfully submits that claim 32 is patentable over Kara in view of Smith and further in view of Cook. Also, claim 32 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 33 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying

Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 33 is patentable over the combination of Kara in view of Smith in further view of Cook. Additionally, the Examiner asserts that Cook discloses the maximum number of days within which to deliver the electronic package to the recipient by referring to figure 4c in Cook. Applicant respectfully traverses this assertion. Figure 4c is not even referenced in the specification other than in the brief description of the drawings and figure 4c merely shows a “days to hold message”, not the required electronic certificate of non-service as claimed by the present invention. Again, this is very important for a Proof of Service, and the mere mention of holding a message does not teach or suggest this feature. Applicant respectfully submits that claim 33 is patentable over Kara in view of Smith and further in view of Cook. Also, claim 33 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 34 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. Claim 34 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 37 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. Claim 37 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

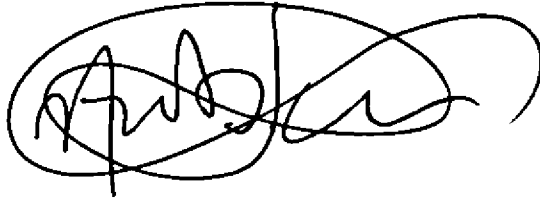
Examiner rejects claim 39 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated

above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 39 is patentable over the combination of Kara in view of Smith in further view of Cook. Also, claim 39 is dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

Examiner rejects claim 40 based on Kara over Smith in further view of Cook. Applicant respectfully traverses this rejection. For the reasons stated above, Kara does not disclose, teach or suggest the Applicant's Certifying Authority. Therefore since Kara lacks the critical information, one skilled in the art and following the teaching of Kara would be led away from the correct solution to the problem. Since it is respectfully proposed that both Smith and Cook lack the crucial teaching regarding the present invention's Certifying Authority, they cannot be used to render the instant invention as obvious either alone or in combination with Kara. Accordingly, it is respectfully submitted that claim 40 is patentable over the combination of Kara in view of Smith in further view of Cook. Also, claim 40 is indirectly dependent from claim 23. Accordingly, it is respectfully submitted that this claim is patentable for the same reasons as claim 23 above, as well as because of the combination of the limitations set forth in this claim with the limitations set forth in amended claim 23 from which it depends.

In view of the foregoing, this application is now believed to be in condition of allowance, which action is respectfully requested.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Mark D. Torche', enclosed within a large, loopy oval shape.

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